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*M. J.*

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/313,534    05/13/99    ROMERO    A    4830.P-RE

HM22/0711

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INTELLECTUAL PROPERTY LEGAL SERVICES  
PHARMACIA & UPJOHN COMPANY  
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EXAMINER

MORRIS, P

ART UNIT

PAPER NUMBER

1625

7

DATE MAILED:

07/11/00

07/11/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/313,534

Applicant(s)

Romero

Examiner

P. Morris

Group Art Unit

1625

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 4-17-00.
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-12 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☒ Claim(s) 1-8 is/are allowed.
- ☒ Claim(s) 9-12 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

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*Reissue Applications*

Claims 1-12 are pending in this application.

The reissue oath or declaration filed with this application is defective because none of the errors which are relied upon to support the reissue application are errors upon which a reissue can be based. See 37 CFR 1.175(a)(1) and see MPEP 1414.

The reissue statute - 35 U.S.C. 251 - provides for the reissue of patents whenever the patent is deemed wholly or partly inoperative or invalid through error without any deceptive intention. Applicant fails to allege that the original patent is inoperative or invalid or fails to state the reason of a defective specification, or of patentee claiming more or less than patentee had the right to claim in the patent.

The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414.

The reissue oath/declaration filed with this application is defective because it fails to contain a statement that all errors which are being corrected in the reissue application up to the time of filing of the oath/declaration arose without any deceptive intention on the part of the applicant. See 37 CFR 1.175 and MPEP § 1414.

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Again, applicant has presented claims 9-12 to multiple inventions that had not been originally claimed and could have been claimed elsewhere. Reissue applicants' failure to timely file a divisional application is not considered to be error causing a patent granted on claims to be partially inoperative by reason of claiming less than they had a right to claim. Failure to file divisional subject matter is not recoverable by reissue.

Claims 9-12 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above and for the reasons set forth in Paper no. 4. See 37 CFR 1.175.

Contra to applicant's arguments in the instant response, applicant has now added claims drawn to multiple, patentably distinct inventions that could not have been claimed in the original patent because they are not drawn to compounds prosecuted in the original patent and could have been claimed elsewhere. Applicants' failure to timely file a divisional application is not considered to be error causing a patent granted on claims to be partially inoperative by reason of claiming less than they had a right to claim. Failure to file divisional subject matter is not recoverable by reissue. Applicant's alleged error is simply to expand the subject matter in the original patent. This is applicant's attempt to circumvent a restriction requirement by filing of this reissue application.

Claims 9-12 are rejected under 35 U.S.C. 251 as being drawn to inventions not claimed in the original patent as evidenced by the claims in the original patent for the reasons set forth in Paper no.4.

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Contra to applicant's arguments in the instant response, the examiner is well aware that a restriction requirement had not been made in the original application.

Applicant's claims are drawn to multiple, patentably distinct inventions that will support separate patents. The fact that applicant has failed to present the newly added claims in the originally filed application is not recoverable by reissue. This is not correctable by reissue of the original patent under 35 U.S.C. 251.

Further, there is no evidence in the specification that applicant ever considered claims 9-12 to be their invention. The summary of the invention and detailed description of the invention in the patent recite that the invention related to the compounds of formula (I) and their uses. The specification fails to recite that applicants ever considered the compounds of claims 9-12 as their invention.

The claims presented for reissue clearly are not directed to the compounds of formula (I) determined to be what applicant had a right to claim in the patent. None of the claims now presented are directed to the originally claimed invention.

There is no real distinction between the holding of *Orita* and the issue presented here in that both circumstances would result in the granting by reissue, claims to the subject matter that would circumvent the copendency requirement of 35 USC 120 and defeat the purpose of making proper restriction requirements of 35 USC 121. One need only present claims to one invention in the original application and upon issuance into a patent then present claims to another and different invention in the reissue. This reasoning does not amount to applying a per se rule

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against reissues to claim subject matter that was not earlier claimed through error and without deceptive intent. Each case must be decided on the facts of the case. In the instant application, applicant should be well aware that the newly added claims do not correspond to the original claims. This is an attempt by applicant to circumvent any restriction requirement.

The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

***Allowable Subject Matter***

Claims 1-8 are allowed.

***Conclusion***

Claims 9-12 are not allowed.

Applicant's arguments filed April 17, 2000 have been fully considered but they are not persuasive.

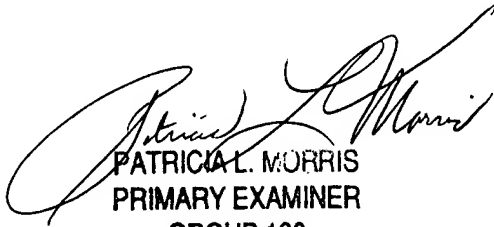
**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ms. Morris whose telephone number is (703) 308-4533.

  
PATRICIA L. MORRIS  
PRIMARY EXAMINER  
GROUP 120

plm

July 7, 2000